

REMARKS/ARGUMENT

Applicants respectfully traverse Examiner's decision to withdraw claim 28 from consideration as being directed to a non-elected invention pursuant to the argument that "applicant has received an action on the merits for the originally presented invention". MPEP 803 specifically states:

If the search and examination of all the claims in an application can be made without serious burden, the **examiner must examine them on the merits, even though they include claims to independent or distinct inventions.**

Nowhere has Examiner set forth an argument and facts supporting such argument that it would be a "serious burden" for Examiner to examine Claim 28. As such, the restriction requirement is improper and must be withdrawn.

1) Applicants respectfully traverse the 35 USC 112, first paragraph, rejection of Claim 19. Even if, arguendo, the only embodiment disclosed in the specification is one of a value being set for "local variables", Examiner's determination is improper and unduly restricts the scope of Claim 19 UNLESS Examiner can point out some teaching in the specification that states that "a value is being set ONLY for local variables". Examiner has cited no such teaching in the specification. As such, Examiner is improperly restricting Applicants to a picture claim. Further, Examiner admits that a "local variable" is a "variable" but states the following regarding a "variable": "the claims and the specification both support fetching not only local variables from memory (Office Action, page 3, lines 16-17). Accordingly, Claim 19 does NOT contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is not nearly connected, to make and/or use the invention, as suggested by the Examiner.

Applicants direct the Examiner to two Supreme Court cases in which the Court held that it is not necessary to recite in the claim everything necessary to operate the device. As stated by Joseph Gray Jackson in *The Art of Drafting Patent Claims*, 59-60:

In Deering v. Winona, 155 U.S. 286 (1894), the device was an agricultural machine and lacked the support necessary for the board which was an element of the claim. The Supreme Court, said, "True that it is necessary and true it is not in the claim but it does not have to be; the claim does not have to include everything that is required to operate."

The other case is Special Equipment v. Coe, 324 U.S. 370, 64 USPQ 525 (1945), in which a subcombination claim was supported which related to a machine for cutting, peeling and coring pears, and there was no cutting knife involved in the claim. The Supreme Court said it is perfectly all right; you do not have to have everything required to operate this device in the claim. Completeness is a much inflated "bugaboo" which is mainly of interest to certain examiners in the Patent Office, and should not really concern them. The claim is not a description of the device in any case. It is like a fingerprint which identifies the device. The fingerprint looks not at all like the person, but it is an identification of the person, and that is what we are interested in - identification.

It is apparent in light of the rejection that the Examiner is really rejecting Claim 19 because he feels the term "variables" is overly broad, MPEP 706.03(d), paragraph 2, states, "The fact that a claim is broad does not necessarily justify a rejection on the ground that the claim is vague and indefinite or incomplete. In non-chemical cases, a claim may, in general, be drawn as broadly as permitted by the prior art." Applicants respectfully point out that a claim, no matter how broad, is not indefinite as long as the boundaries of the claim are capable of being understood. Applicants' Claim 19 is clear, definite, complete and capable of being understood. The present case is a non-chemical case and the breadth of Claim 19 is permitted by the prior art.

Claims 22-24 have been amended to overcome the 35 U.S.C. 112, first paragraph, rejection.

2) Claims 1, 2, 5, 6, 10, 11, 13, 14, 19 and 20 stand rejected under 35 U.S.C. 102(b) as being unpatentable over Tremblay et al. [6,067,602] (hereinafter "Tremblay"). Applicants again traverse this rejection. However, Applicants are desirous to obtain a patent at the earliest date on the objected to claims and those additional dependent claims that have been amended to depend upon objected to rather than rejected claims. Accordingly, Claims 1, 2, 10 and 11 have been canceled. Nevertheless, Applicants maintain their traversal of the rejection of these claims and reserve the right to file a divisional application to further pursue the subject matter of these claims.

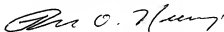
3) Objected to Claims 3, 4, 7, 12, 15 and 18 have been amended to include the limitations of their respective base claims and any intervening claims. Claim 8, 9, 16 and 17 depend from now allowable claims and are therefore similarly allowable. Claim 5 has been amended to depend from allowable Claim 4. Accordingly, Claim 5 and Claim 6, which depend on Claim 5, are now allowable. Claim 13 has been amended to depend from allowable Claim 12. Accordingly, Claim 13 and Claim 14, which depend on Claim 13, are now allowable. Claims 20-21, which depend on Claim 19, are allowable for the same reasons provided above in support of the allowance of Claim 19. Dependent Claims 22-27 are allowable for depending from allowable Claims.

Regarding Claim 28, maintain their argument that Claim 28 should be examined by the Examiner and respectfully submit that it is allowable of the cited references. Nevertheless, if the restriction requirement is the only remaining issue impeding allowance of this application, Applicants will authorize Examiner to cancel Claim 28. This permission to cancel Claim 28 is extended to the Examiner ONLY canceling of Claim 28 will result in a Notice of Allowance being issued on this application.

An amendment after a final rejection should be entered when it will place the case either in condition for allowance or in better form for appeal. 37 C.F.R. 1.116; MPEP 714.12. This amendment places the case in condition for allowance.

Claims 3-9 and 12-27 are allowable over the cited art. Applicants respectfully requests withdrawal of the rejections and allowance of the application at the earliest possible date.

Respectfully submitted,



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